



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

maj

Paper No. 7

Mark Pohl  
PHARMACEUTICAL PATENT ATTORNEYS  
POHL & ASSOCIATES  
55 Madison Avenue, 4<sup>th</sup> Floor  
Morristown, NJ 07960-6397

(For Patent Owner)

MAILED

DEC 10 2003

REEXAM UNIT

In re Szynalski  
Reexamination Proceeding  
Control No. 90/006,704  
Filed: June 30, 2003  
For: U.S. Patent No. 6,431,874

:  
:  
:  
:  
:  
: **DECISION *SUA***  
: ***SPONTE* MERGING**  
: **REEXAMINATION**  
: **AND REISSUE**  
: **PROCEEDINGS**  
:  
:  
:  
:

In re reissue application of  
Szynalski  
Application No. 10/613,590  
Filed: June 30, 2003  
For: U.S. Patent No. 6,431,874

The above-identified reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

### **REVIEW OF FACTS**

1. U.S. Patent No. 6,431,874 issued to Szynalski, on August 13, 2002.
2. A request for reexamination of the '874 patent was filed by patent owner on June 30, 2003, and the resulting reexamination proceeding was assigned Control No. 90/006,704.
3. Patent owner filed a reissue application based on the '874 patent, also on June 30, 2003, which was assigned Application No. 10/613,590. Claims 9-45 were added.
4. Reexamination was ordered in the '6704 proceeding on August 27, 2003.
5. A patent owner's statement was filed in the '6704 proceeding on October 8, 2003.
6. Notice of the filing of the reissue application was published in the *Official Gazette* on October 21, 2003.
7. A certificate of correction was issued in U.S. Patent No. 6,431,874 on November 18, 2003, in which Col. 12, lines 26-27 and 45, were amended.

### **DISCUSSION REGARDING MERGER**

Under 37 C.F.R. § 1.565(d):

(d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the Order has been mailed pursuant to § 1.525 in the '6704 reexamination proceeding, a decision under § 1.565(d) is timely.

The general policy of the Office is that examination of reissue and reexamination proceedings will not be conducted separately and at the same time for a single patent. The reason for this

policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of all of the proceedings. In making a decision on whether or not to merge the multiple proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the prosecution history of the '6704 reexamination file shows that no amendments were made in the reexamination file.

A review of the reissue (Application No. 10/613,590) prosecution history shows that the reissue application was published in the *Official Gazette* on October 21, 2003. In the reissue application, patent owner has added claims 9-45. Therefore, the claims are **not** identical in both proceedings.

Also, since a certificate of correction was issued in U.S. Patent No. 6,431,874 on November 18, 2003, in which Col. 12, lines 26-27 and 45, were amended, the specifications in both the reissue application and the reexamination proceeding need to be updated to reflect such changes to the original patent.

In order to provide efficient and prompt handling of both proceedings, and to prevent inconsistent and possibly conflicting amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be conducted in accordance with the decision set forth below.

### **DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS**

#### **I. Merger of Proceedings**

The above-identified reissue and reexamination proceedings are merged. A joint examination will be conducted in accordance with the guidelines and requirements which follow.

#### **II. Requirement for Same Amendments in Both Proceedings**

The patent owner is required to maintain identical amendments in the reissue application and the reexamination file for purposes of the merged proceeding. The maintenance of identical

amendments in both files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d). As noted above with regard to the amendments submitted, the claims are NOT the same in both files. As also noted above, the specifications need to be updated to reflect the changes to Col. 12 of the patent made via certificate of correction. **An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases**, specifically, Application No. 10/613,590, and Control Number 90/006,704. The response to the requirement must be limited to placing the same amendments in both cases, and patent owner must **not** address the issues of either of the proceedings in the housekeeping amendment. The housekeeping amendment should be submitted as a single paper, including the identifying data for both files (*i.e.*, the reissue Application No. and the reexamination proceeding Control No.) and a signature, and should be filed in duplicate for entry into each of the reissue and reexamination files.

It should be noted that the preliminary amendment filed on June 30, 2003, adding claims 9-45 in the reissue application, is **not** in the proper format for reissue applications, because the newly added claims are **not** underlined. **Amendments in a reissue application must be in compliance with 37 C.F.R. § 1.173**, therefore all new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2). Please be aware that a "clean copy" of the amendment is **not** required by this rule. **Note that amendment practice pursuant to 37 C.F.R. § 1.121 does not apply to reissue applications, as specifically indicated in 37 C.F.R. § 1.121(a) and (h), and therefore "Revised Amendment Practice" does not apply to reissue applications.** Therefore, the required housekeeping amendment must be in compliance with 37 C.F.R. § 1.173, *e.g.*, all new claims must be completely underlined pursuant to 37 C.F.R. § 1.173(b)(2) and (d)(2).

Note that the changes made to the specification via certificate of correction constitute part of the original patent, therefore these changes need to be incorporated in the specifications of the reissue and reexamination proceedings, but **without** any bracketing and underlining since the changes are **not** being made via the reissue application or the reexamination proceeding.

### III. Conduct of the Merged Reissue and Reexamination Proceedings

Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding.

Each Office action issued by the examiner will take the form of a *single action* which jointly applies to the reissue application and the reexamination proceeding. Each action will contain

identifying data *for both of the cases, i.e.*, the reissue application and the reexamination proceeding. Each action will be physically entered into both files (which will be maintained as separate files).

Any response by the applicant/patent owner must consist of a single response, with **two copies being filed** for entry in both files, with each of the two copies bearing a signature, and containing identifying data for both of the cases (*i.e.*, the reissue Application No. and the reexamination proceeding Control No.).

If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 C.F.R. § 1.570. See MPEP 2285.

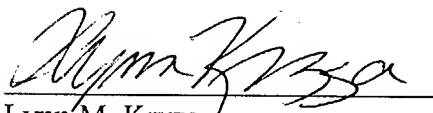
If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated as follows. The reissue application will be held abandoned, and the merger will be dissolved. With respect to the reexamination proceeding, the Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed as a result of the difference in rules relating to reexamination and reissue proceedings.

If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue examination as to the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improperly broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions/issues remaining which cannot be considered under reexamination following the dissolution would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

### CONCLUSION

1. The above-identified reissue application and reexamination proceeding **ARE MERGED** into a single consolidated proceeding.
2. The reissue application file and the reexamination file are being forwarded to the Group Director of Technology Center 3600. All further examination should be conducted in accordance with this decision.

3. Pursuant to Part II of this decision, a housekeeping amendment is required **within ONE (1) MONTH of this decision**, placing the same amendments in both cases of the present merged proceeding, which amendment must be in compliance with 37 C.F.R. § 1.173.
4. The examiner should issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding **after** the earlier of:
  - (a) the submission of the housekeeping amendment to place the same amendments in both cases
  - (b) the expiration of the ONE (1) month period from the mailing of this decision for filing the amendment.
5. It should be noted that failure to submit an appropriate "housekeeping amendment" **within one month of this decision** placing the same amendments in both files will result in the Office's rejection of any claim that does not contain identical text in both merged proceedings under 35 U.S.C. § 112, second paragraph, as being indefinite as to the content of the claim, and therefore failing to particularly point out the invention.
6. All further examination should be conducted in accordance with Parts II and III of this decision.
7. Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-0255.

  
Lynn M. Kryza

Patent Special Projects Advisor  
Office of Patent Legal Administration

December 9, 2003